

REMARKS

RESPONSE TO THE ELECTION/RESTRICTION REQUIREMENT

In the outstanding Office Action, the Examiner finalized the previously imposed restriction requirement between Group I claims 1-19 directed to a composition and Group II claims 20-21 directed to a method of using the composition, while acknowledging Applicants' previous election of the Group I composition claims 1-19.

However, in light of the fact that the non-elected Group II method claims 20-21 are directed to the method of using the composition and contain all the limitations of the elected Group I claim 1, Applicants hereby request the Examiner to rejoin the non-elected, withdrawn method claims 20-21 for future examination once the elected Group I claim 1 is found allowable. Such request for future rejoinder is specifically based on the provisions of MPEP §821.04. Correspondingly, Applicants will continue to maintain the non-elected, withdrawn method claims 20-21 in conformity with the elected composition claims 1-19 for the intended future rejoinder.

RESPONSE TO THE §103 REJECTIONS

In the outstanding Office Action, the Examiner rejected claims 1-19 as allegedly obvious over **Krysik** U.S. Patent No. 5,330,747 (hereinafter "Krysik") in view of **Castrogiovanni et al.** U.S. Patent No. 5,505,937 (hereinafter "Castrogiovanni"). Specifically, the Examiner asserted that **Krysik** discloses PSA including the trialkylorganosilyl-endblocked silica dioxide reacted with polydialkylorganosiloxane with the claimed viscosity and molecular weight and the use of such PSA in cosmetics applied to the skin and eyes, and **Castrogiovanni** exemplifies the general

use of PSA in lipsticks. Therefore, the Examiner concluded that it would be obvious for one ordinarily skilled in the art to use the type of PSA disclosed by **Krysik** in lipsticks, as exemplified by **Castrogiovanni**.

In response, Applicants have hereby amended claims 1 and 9, from which claims 2-8 and 10-12 depend, to positively recite positively recite a two-part lip product that comprises “a base coat and a separate top coat, ... wherein the top coat comprises at least one non-volatile solvent that is insoluble in both water and non-polar hydrocarbons,” as described by the instant specification of the present application on page 2, lines 17-19 and page 5, lines 26-34. Similarly, claim 20, from which claim 21 depend, has been amended to positively recite a method of achieving long wear of a lip product, which comprises the steps of “applying to the lips a base coat.... allowing the base coat to dry on the lips, and applying over the base coat a separate top coat comprising a primary component that is not soluble in either water or a nonpolar hydrocarbon,” as described by the instant specification of the present application on page 6, lines 18-21. Further, new claims 22-25 have been added to respectively recite the function of the top coat and exemplary compounds that can be used for forming the top coat, as described by the instant specification on page 5, lines 28-34 and page 6, lines 1-4.

In this manner, all claims of the present application (including the original claim 13, from which claims 14-19 depend) recite a combination of a base coat and a separate top coat for application to the lips, wherein the top coat contains a primary component or a non-volatile solvent that is not soluble in either water or nonpolar hydrocarbons. Such a separate top coat provides a glossy or shiny finish without disrupting the base coat’s integrity, as recited by the new claims 22 and 24 and described by the instant specification on page 5, lines 28-29.

Neither **Krysik** nor **Castrogiovanni** teaches or suggests such a combination of a base coat with a separate top coat for application to the lips, let alone a separate top coat comprising a primary component or a non-volatile solvent that is not soluble in either water or nonpolar hydrocarbons, as positively recited by all the claims of the present application.

Therefore, claims 1-25 of the present application as amended herein patentably distinguish over the cited references **Krysik** and **Castrogiovanni**, by positively reciting both a base coat and a top coat comprising a primary component or a non-volatile solvent that is not soluble in either water or nonpolar hydrocarbons. Correspondingly, Applicants request the Examiner to withdraw the obviousness rejections against such claims.

Respectfully submitted,



Yongzhi Yang (Reg. No. 56,310)
Estée Lauder Companies
155 Pinelawn Road, Ste. 345 S.
Melville, NY 11747
Telephone No.: 631-414-6089
Facsimile No.: 631-531-1340